Remarks

Claims 1 and 8 to 35 are pending and before the Examiner. Applicants point out that similar issues are present and similar rejections have been made in copending U.S.S.N. 10/757,295, which is also being examined by the Examiner.

The Examiner maintained the rejection of claims 1 and 8 to 17 as allegedly not enabled under 35 U.S.C. § 112, first paragraph.

In response, applicants again traverse the rejection as improper. "When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement". *In re Wright*, 27 U.S.P.Q. 1510, 1513 (Fed. Cir. 1993)(emphasis added).

The Examiner alleges that the term "prevent" requires absolute success and that this is the "broadest reasonable interpretation". Applicants again maintain that this is an unreasonable interpretation of the meaning of prevention, is contrary to what one of ordinary skill in the art would understand "prevent" to mean in the context of the invention, and is accordingly improper. The Examiner refuses to follow the reasoning of *Ex parte Cho*, Appeal No. 2001-2646 (Bd. Pat. App. & Int. 2002)(nonprecidential), even though as the Examiner recognizes "Applicant is claiming a discrete combination of two very well-known chemical entities", while *Ex parte Cho* was claiming a "broad genus of compounds", which would make Cho's successful showing of enablement even more difficult than the instant claims. As the Board stated, "Logically, if the recited compounds are useful for treating conditions such as pain and inflammation once they exist, they would also be expected to be effective in preventing pain and inflammation, if they were administered before the onset of pain or inflammation." (emphasis in original) is a generalized statement not limited to the specific technology of *Ex parte Cho* and there is no apparent concern for enablement about how such patients could be identified. The Examiner concedes enablement of the instant claimed combination for treatment of the recited conditions, which would make the logical generalization of *In re Cho* even more obviously on point. Unreasonable interpretations of claim terms are the basis for

reversal of the Office. See *In re Buszard*, – F.3d –, 207 WL 2791699 (Fed. Cir. September 27, 2007)(copy enclosed for the convenience of the Examiner)(Board's claim interpretation was not reasonable and accordingly rejection reversed); see also *Ex parte Konieczynski*, Appeal No. 2007-1707 (Bd. Pat. App. & Int. 2007)(nonprecidential)(copy enclosed for the convenience of the Examiner)(Examiner's claim interpretation was not reasonable and accordingly rejection reversed). The Examiner apparently believes that enablement of prevention claims requires that applicants provide guidance to identify "patients in need of prevention in such a condition could be identified if they are not showing any proclivity to developing such a condition". Again, the Examiner is requiring the impossible as a standard for enablement, now by requiring applicants to somehow identify every patient that could conceivably benefit from the claimed method, even if, by the Examiner's circular and flawed reasoning, there is **by definition** no evidence to believe that such patients will benefit from the treatment (as these mystery patients are patients "not showing *any proclivity* to developing such a condition"). Applicants are therefore required by the Examiner with the unattainable task of identifying patients that would benefit from preventive treatment but do not provide any evidence of developing any of the conditions in the claims. This is irrational. Enablement, of course, does not require perfection, satisfaction of every remote speculation by the Examiner, or impossible standards.

The essential point is that such suitable patients having symptoms or conditions amenable to preventive treatment and the pharmaceutical is administered to such patients, the pharmaceutical would be expected to have a prophylactic effect based on the demonstrated biological activity. Such would be expected to be the reasoning used in order to obtain regulatory approval for such a pharmaceutical, which is certainly more strict than is required for satisfaction of the enablement requirement. The Office has been repeatedly reversed for rejecting for lack of enablement claims directed to compounds having demonstrated pharmaceutical and biological activity. *See* M.P.E.P. § 2107 (particularly §§ 2107.01 III/IV and 2107.03, discussing the relationship of the utility and enablement requirements and the role of the FDA) and § 2164 (particularly § 2164.06). It is very likely that the Board would follow the reasoning of *Ex parte Cho* in the instant case, since there is no case that the Examiner has cited that is to the contrary effect and the Board will try to be consistent (this is hardly speculation, but the very basis for rational decisionmaking). Accordingly, applicants again respectfully request that the Examiner reconsider and withdraw the rejection.

The Examiner also again rejected claims 1 and 8 to 35 as allegedly unpatentable under 35 U.S.C. § 103(a) over De Gasparo *et al.*, in light of Robl *et al.*, in view of Cecil's Textbook of Medicine (2000), Harlan *et al.* (U.S. Patent Appl. Pub. No. 2001/0006656), and Bohm *et al.* (WO 02/15891).

Applicants again respectfully traverse the rejection. A *prima facie* case of obviousness generally requires the satisfaction of three criteria: (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings; (ii) there must be a reasonable expectation of success; and (iii) the references when combined must teach or suggest all of the claim limitations. *See* M.P.E.P. § 2143. De Gasparo *et al.* does not specifically disclose the specific combination of telmisartan and simvastatin anywhere. The teachings and statements in De Gasparo *et al.* must be considered in context and interpreted as a whole. De Gasparo *et al.* does not give any preference to any particular combination within the broad disclosure, certainly not a specific combination of telmisartan and simvastatin. Indeed, De Gasparo *et al.*, at page 3, line 22, merely defines "AT_1 receptor antagonists" as including a number of commercially available sartans including telmisartan, which is not disclosed as a selected compound in the context of a specific combination, much less with simvastatin. The only sartan specifically mentioned in De Gasparo *et al.* in the context of a specific combination is valsartan which actually teaches away from telmisartan as a preferred combination partner. Similarly, in De Gasparo *et al.*, simvastatin is mentioned on page 5, lines 7 and 10, but not in the context of a specific combination, much less with telmisartan. On page 5, line 27, and page 6, line 1, De Gasparo *et al.* teaches that simvastatin is a preferred or most preferred composition partner with valsartan (not telmisartan), again teaching away from telmisartan as a preferred combination partner of simvastatin. Instead De Gasparo *et al.* on page 6, lines 8 and 11 refer to a combination of statins such as simvastatin with ACE inhibitors while there is no analogous teaching with regard to AT_1 receptor antagonists. Furthermore, none of Robl *et al.*, Cecil's Textbook of Medicine, Harlan *et al.*, or Bohm *et al.* provide what De Gasparo *et al.* lacks in providing to one of skill in the art a motivation, reasonable expectation of success, or teaching or suggestion of all of the claim limitations of the claimed invention.

First, Robl *et al.* does not teach structures which encompass simvastatin, does not teach combinations of simvastatin with any compound except for the class of HMG-CoA reductase inhibitors claimed, and does not mention telmisartan. Second, the teaching of Harlan *et al.* is confined to aerosol formulations of statins while said formulations are not intended to combine a statin such as simvastatin with an antihypertensive much less with telmisartan. Third, the teaching of Bohm *et al.* is confined to a combination of telmisartan with the ACE inhibitor ramipril, i.e., to two active ingredients acting on the renin-angiotensin system but not on HMG-CoA reductase. Fourth, Cecil's Textbook of Medicine neither mentions telmisartan nor simvastatin. Finally, neither De Gasparo *et al.*, Robl *et al.*, Cecil's Textbook of Medicine, Harlan *et al.*, nor Bohm *et al.* teach or suggest that telmisartan increases the expression of genes regulated by the PPARgamma receptor, i.e., an activity known from antidiabetic drugs, which is the reason that telmisartan is a preferred combination partner for simvastatin in the treatment of, e.g., diabetes, and this metabolic activity appears to be unique for telmisartan and is not recognized in the prior art. Indeed, De Gasparo *et al.* teaches the use of AT_1 receptor antagonists of "differing structural features" and therefore suggests that the specific chemical structure is of no concern and none of the other art cited makes up for this defect. Furthermore, neither Harlan *et al.* (disclosing an aerosol formulation of statins) nor Bohm *et al.* (disclosing a combination of telmisartan with ACE inhibitors) disclose, suggest, or hint at telmisartan combinations with statins and it is unclear why or how one of skill in the art at the time the claimed invention was made would combine their teachings with De Gasparo *et al.* Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants submit that all the pending claims are allowable and respectfully solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Respectfully submitted,

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